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June 21, 2007

Mail Stop Appeal Brief - Patents
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PO Box 1450
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Re:	Application No.:	10/603,266
	Appeal No.:	2007-0069
	Confirmation No.:	7160
	Applicants:	Enright, et al.
	Title:	System and Method for Capturing and Searching Image Data Associated with Transactions
	Docket No.:	D-1112 R2 DIV

Sir:

Please find enclosed Appellants' Request for Rehearing of the Decision (dated May 3, 2007) of the Board of Patent Appeals and Interferences in Appeal No. 2007-0069.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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Ralph E Jocke

D-1112 R2 DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
Jeffery M. Enright, et al.	)	
	)	
Application No.: **10/603,266**	)	Art Unit 2621
	)	
Confirmation No.: **7160**	)	
	)	Patent Examiner
Filed: **June 23, 2003**	)	Anand Shashikant Rao
	)	
Title: **System and Method for Capturing**	)	
and Searching Image Data	)	
Associated with Transactions	)	

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING OF BOARD DECISION

Sir:

Appellants hereby request rehearing of the Decision (dated May 3, 2007) of the Board of

Patent Appeals and Interferences (hereinafter "Board") in Appeal No. 2007-0069 pursuant to 37

C.F.R. § 41.52.

THE BOARD'S BASIS FOR SUSTAINING THE REJECTIONS

The Board's asserted basis for sustaining the rejections can be found at Decision page 7 (numbered paragraph 5) and page 10. The asserted basis is as follows:

Anderson discloses that it is known to use a markup language to identify and generate financial markup language documents in order to provide a tagged structure of checks in order to implement a conventional well known web browser procedure for verification purposes in electronic transactions across the Internet. Anderson at columns 18, 19, and 28 discloses using markup languages to display transaction data, and images, as claimed and as disclosed by Appellants.

Gustin teaches using TIFF images of checks, and verifying signature and transaction data over networks (col. 13).

Gustin discloses an ATM machine with scanned images of submitted checks and other standard ATM features, plus connection to remote terminals for transferring the image data and transaction data (in the "Analysis" section at Decision page 10).

The Board concludes that because Anderson addresses the same field of endeavor as Gustin, with the added teaching of the Internet and markup language protocols for the same image and transaction data, it finds the rejection based on the two references to be appropriate for rendering the claims obvious.

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Points Believed to Have Been
Misapprehended or Overlooked by the Board

I. The legal standard for review was overlooked by the Board

The Decision does not follow the legal standard for review of rejections made pursuant to

35 USC § 103. Thus, the Decision is erroneously based.

The Decision does not meet the legal standard for review:

<u>35 USC § 103</u>

> Obviousness requires a prior art showing of all recited features and relationships.
>
> In addition, before there can be a valid finding of obviousness, there must be an
>
> explicit reason based on prior art knowledge to combine the known features and
>
> relationships in the manner recited in the claim. *KSR International Co. v. Teleflex*
>
> *Inc.*, U.S., No. 04-1350, 4/30/07.
>
>
> Determining whether there is such a bona fide reason to combine features and
>
> relationships known in the prior art requires that an analysis be conducted which
>
> considers:
>
>
> • the interrelated teachings of the multiple patents, the features and
>
>   relationships of which would need to be combined to produce the claimed
>
>   invention,

- the effects of demands known to the design community or present in the marketplace at the time of the invention, that would give one having skill in the art a particular reason to combine the features and relationships of the cited prior art references to produce the claimed invention, and

- the background knowledge in the possession of one having ordinary skill in the art at the time the invention was made, and whether such background knowledge would provide a particular reason to combine the features and relationships of the prior art to produce the invention as claimed.

KSR, Supra

In addition, in accordance with *KSR* it is helpful in determining questions of obviousness to determine if there is some prior art teaching, suggestion, or motivation to combine the features.

> *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). *Dickinson v. Zurko*, 527, U.S. 150, 50 USPQ2d 1930 (1999).

Furthermore, the Supreme Court's ruling in KSR constitutes good cause to present new arguments based thereon that the Decision is not based on the appropriate legal standard. 37 C.F.R. § 41.52(a)(2).

II.   The Decision is based on critical factual errors

Appellants respectfully submit that the Board used an improper legal standard and an unduly broad brush in determining obviousness. Appellants respectfully submit that the Board's basis for sustaining the rejections also contains critical errors of fact. The Decision is based on these errors. The Decision also ignores certain facts of record. As a result, the Decision is erroneous.

Error #1

The Board's relies on Gustin for teaching *"verifying signature . . . over networks"* and "an ATM machine with scanned *images* of submitted checks . . . plus connections to remote terminals for *transferring the image data.*" The Board's reliance is without basis. Gustin does not teach or suggest using a network to verify a check signature, as relied upon by the Board.

Gustin's ATM does not transfer a signature image over any network, especially for the purpose of signature verification, as alleged by the Board. In Gustin, character recognition software and the signature verification software are both resident in the ATM. That is, signature verification is performed locally at the ATM. For example, Gustin teaches that the ATM processor (21) "by executing document verification software will then analyze the signature image and compare it with the profile signature of the user" (col. 17, lines 2-5). The check image

(and check signature) is stored locally in the ATM as a TIFF file (Gustin's claim 31; col. 26, lines 32-33). That is, in Gustin the check image and the check signature remain at the ATM.

The Decision is incomplete because the Board never stated on the record (nor can it) exactly where Gustin teaches the relied upon features of:

(1) The transferring (from an ATM) of a signature image over a network; and

(2) The verifying of a signature using a network.

Appellants further respectfully submit that because Gustin does not transfer a signature image over a network, one skilled in the art would not have found it obvious for Gustin to use a network to verify a signature (as alleged by the Board). It follows that the Decision is erroneous.

Error #2

Anderson and Gustin are not directed to the same purpose of using a network for signature verification, as relied upon by the Board. The Board's reliance on Anderson teaching "markup language protocols for the same image and transaction data" as Gustin is without basis. The Board ignores when Gustin's communication occurs and where Anderson's electronic check protocol is used.

Gustin's ATM communication is limited to an ATM host. Both Gustin and Anderson use a proprietary bank network for their ATM to ATM host communication. There isn't any prior art teaching or suggestion of record of using a markup language protocol to communicate between an ATM and its host.

The Board is requested to clarify the record by specifying exactly where:

(1)   The prior art of record teaches or suggests using markup language protocol to communicate between an ATM and its ATM host.

As discussed in detail in Appellants' Briefs, Gustin only teaches that an indication that the signature was verified by the ATM processor (21) and the check amount are forwarded to the bank network (col. 13, lines 44-47). The bank network is the ATM host. Thus, Gustin teaches sending a verification status and the check amount from the ATM to the ATM host. Gustin specifically teaches that after the ATM processor (21) has verified the check signature, then "the banking network is accessed in a step 532 to determine whether the check has a balance from which the check may be cashed" (col. 16, lines 40-46). The secure communication between Gustin's ATM and the ATM host is proprietary.

Anderson likewise uses a bank network to check an account balance. Anderson uses existing bank infrastructure, including the mechanisms currently used for interbank clearing of checks, such as the standard banking channel Electronic Check Presentment (ECP) (col. 7, lines 5-10; col. 15, lines 28-34). Anderson clears a check via existing electronic settlement procedures (such as ECP, not markup language documents) carried out over proprietary banking networks (col. 24, lines 15-24; col. 29, lines 62-64; Figure 3).

Anderson in Figure 3 specifically shows that his electronic transaction system keeps the secure banking network side (80) separate from the not secure public network side (65). As a result, all review of account balances in Anderson is conventionally performed (without a markup language document) through existing proprietary communication on the secure banking network side (80) (col. 24, lines 25-36; col. 30, lines 2-3; col. 38, lines 32-33).

Anderson (like Gustin) also teaches conventional use of a bank to determine if there are sufficient funds in a payer's account to cover a check amount. If there are sufficient funds, then payment is sent to the payee's bank "*over the financial network* 80 to settle the payment" (col. 24, lines 31-36). Anderson's financial network uses secure proprietary bank network protocols, not markup language protocols (or markup language documents), as relied upon by the Board.

Additionally, Anderson teaches delivering an electronic check via e-mail (col. 28, lines 58-59) on the public network side (65). Deposits consisting of electronic checks are gathered by banks via e-mail (col. 29, lines 60-62). However, the check data is cleared on Anderson's secure banking network side (80) through standard (proprietary) banking channels (col. 29, lines 60-62), such as previously discussed ECP.

Again, both Gustin and Anderson employ conventional check processing that uses existing proprietary financial networks and protocols (which do not include markup language protocols). That is, in both references proprietary networks are used for account balance determination. Neither reference provides any teaching or suggestion of using markup language protocols to verify a check amount against an account balance (i.e., Gustin's ATM communication purpose). Anderson does not use his electronic check protocol for account balance determination. Rather, Anderson teaches using the same conventional method (i.e., proprietary banking network protocols) for account balance determination that Gustin uses. It follows that there is no communication protocol link between Anderson's electronic checks and Gustin's account balance determination.

Appellants have shown that Gustin does not send any signature image from the ATM to the banking network, as alleged by the Board. Appellants have further shown that even if Gustin

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did send such a signature image, it would be sent on Gustin's secure proprietary network which does not have markup language protocols, especially Anderson's markup language protocols. Appellants have further shown that even Anderson (like Gustin) does not use markup language protocols with his secure proprietary network. Therefore, for the Board to allege that it would be obvious for Gustin's ATM/ATM host (banking network) communication to use Anderson's markup language protocols, especially when Anderson himself does not use the markup language protocols for his own banking network communication, would be disingenuous.

One skilled in the art would not have found it obvious for Gustin to use markup language protocols to verify a check amount against an account balance, especially when such use is absent in (and contrary to) the teachings of both relied upon references.

Error #3

The Board's reliance on compatible "tags" in Gustin and Anderson is without basis. Even if Anderson's markup language protocol was somehow used in ATM/ATM host communication (which it isn't, as previously discussed), Anderson's tag structure still couldn't be used to replace Gustin's tags.

Anderson has markup language tags which are used for instructing a computer. Gustin has conventional transaction identification tags (col. 4, lines 21-23; col. 13, lines 1-4). Gustin's tags are used for storing and retrieving check images. That is, Anderson has *instruction* tags, whereas Gustin has *identification* tags.

Anderson's tag structure can't be used with Gustin's check images, as alleged by the Board (via agreement with the Examiner's Answer at page 4). Nor does Gustin have any need of

Anderson's tags. Again, Gustin teaches that a check is scanned at an imaging station (55), and then the check image is stored in the ATM as a TIFF file (col. 26, lines 32-33).

One skilled in the art would not have found it obvious to equip Gustin's TIFF images with Anderson's markup language (instructional) tags, especially when these images are not even transmitted from Gustin's ATM.

The Board's reliance on improper hindsight reconstruction

Appellants have shown (in Errors #1, #2, and #3) that the Board's attempt to combine the references is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and cannot constitute a valid basis for a finding of obviousness. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). The Decision, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellants' disclosure.

The Board did not apply the correct legal test for obviousness

Determinations as to obviousness are to be based on the standard set forth by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). In making determinations as to obviousness, four factual inquiries must be made, namely:

(A) determining the scope and content of the prior art;

(B) ascertaining the differences between the prior art and each of the claims at issue;

(C) resolving the level of ordinary skill in the art; and

(D) evaluating evidence of secondary considerations.

See also MPEP §2141

The Board's decision fails to make these fundamental factual inquiries or cite to applicable legal precedent. Rather the decision cites for support to *Texas Digital Sys. Inc. v. Telegenix Inc.*, 308 F. 3d 1193, 64 USPQ 2d 1812 (Fed. Cir. 2002). The holding in *Texas Digital* was effectively overruled by the Federal Circuit's en banc decision in *Philips v AWH Corp.*, 415 F. 3d 1303 (Fed. Cir. 2005). Therefore the legal standard applied in the Decision is not appropriate.

In addition, the Decision fails to explicitly articulate reasons to combine features and relationships found in the prior art, as is required under the Supreme Court's holding in *KSR*. Further the decision fails to consider the factors as required by the Supreme Court in *KSR*, including:

- the interrelated teachings of the multiple patents, the features and relationships of which would need to be combined to produce the claimed invention,

- the effects of demands known to the design community or present in the marketplace at the time of the invention, that would give one having skill in the art a particular reason to combine the features and relationships of the cited prior art references to produce the claimed invention, and

- the background knowledge in the possession of one having ordinary skill in the art at the time the invention was made, and whether such background knowledge would provide a particular reason to combine the

features and relationships of the prior art to produce the invention as claimed.

For these reasons the Decision was not rendered in conformance with controlling legal precedent, and is therefore erroneous.

III.   The claim language was misapprehended by the Board

Claims 70 and 79

The Board ignores that in its relied upon Internet teaching it is an Internet host server which performs the sending out of data. Yet in its alleged modification to Gustin, somehow it is Gustin's local ATM (instead of a host server) which ends up sending the data. The Board can't have it both ways. The references, even if it were somehow possible to combine them (which it isn't), still wouldn't teach or suggest (nor is there any prior art reason for) operating a server to communicate a markup language document from an automated banking machine. As a result, the Decision is erroneous.

Claim 73

Claim 73 was not addressed in the Decision. The reason for its sustained rejection is not of record and remains unclear. As a result, the Decision is incomplete.

Claims 74-78

Method claim 74 (and claims 75-78) is directed to operating a terminal, which is located remote from the automated banking machine, to receive the markup language document. The Board relies on Gustin at col. 13, lines 25-45 for teaching "signature analysis at a remote location" (Decision at paragraph number 9).

As discussed in detail in Appellants' Briefs, Gustin teaches that "signature analysis" is performed in the ATM, not at a terminal remote from the ATM. For example, Gustin teaches that the ATM processor (21) "by executing document verification software will then analyze the signature image and compare it with the profile signature of the user" (col. 17, lines 2-5). That is, the software referred to in the relied upon section of Gustin is software installed and operated on the ATM, not at a terminal remote from the ATM. As a result, the Decision is erroneous.

The Board also ignores the recited well known art term remote "terminal." For example, note "terminal" in the Microsoft Computer Dictionary (e.g., 5th edition, 2002). Instead, the Decision attempts to water down the actual claim language to "remote location" in order to sustain the rejections. As the actual claim language was not considered by the Board, the Decision is further erroneous.

Claim 80

With regard to claim 80, the references further do not teach or suggest communicating a markup language document containing check data from a cash dispensing automated banking machine responsive to operation of a server component (of a computer in operative connection with an imaging device of the machine), and further operating a remote terminal (including a terminal computer and a terminal operator input device) to receive the markup language document and the data.

The Decision alleges that Gustin (at col. 12, lines 55+) provides the teaching of claim 80. However, the operation performed at the relied upon section of Gustin is performed *in* the ATM. Conversely, the "terminal" of claim 80 is *"remote* from the automated banking machine." Thus, the Decision is erroneously based.

Claims 81-85

With regard to claims 81 and 82, the references further do not teach or suggest searching terminal data for a selected parameter (e.g., user name, account number, time, or date) responsive to operator input to an *operator* input device of a remote terminal. As the record does not show where the relied upon features are taught or suggested, the Decision is improperly based.

With regard to claim 84, the references further do not provide support for the Decision's reliance thereon for producing a visual representation of the indicia on the check responsive to operation of a browser component of the remote terminal, and for providing the visual representation through an output device of the remote terminal. As a result, the Decision is further erroneous.

Claim 86

The Board improperly limits the features of claim 86 to those of claim 1. With regard to claim 1 the Board alleges that the "markup language document as claimed need only contain information corresponding to the information on the *check*" (Decision page 7, first paragraph). (Appellants do not necessarily agree with this interpretation of claim 1). Nevertheless, the Board disregards the actual language of claim 86, which specifically recites that the markup language document corresponds to the captured *image*. As the actual claim language was not considered by the Board, the Decision is erroneously based.

The Other Claims

For similar reasons already addressed, the Decision is also erroneous with regard to the remaining claims.

IV. The burden of proof was misapprehended by the Board

It is the duty of the Board to "review adverse decisions of *examiners* upon applications for patents" (35 USC § 6(b)). However, the record reflects that the Board only based their Decision on whether the *Appellants'* arguments proved error in the Examiner's rejections. That is, the Board improperly based the Decision only on a review of the Appellants' arguments rather than on a review of the Examiner's decisions with regard to the issues of patentability.

Evidence that the Board improperly placed a burden of proof on Appellants can be found in the Decision. For example, the Decision states (at page 4) that "The issue is whether Appellants have shown that the Examiner erred in rejecting claims," and further states (at page 9) that "Appellants bears [sic] the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims."

There is no legal basis for shifting the burden of proof from the Examiner onto Appellants. Nor has the Board provided any such legal citation. Rather, the burden of establishing a *prima facie* case of obviousness resides with the Office. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

The burden is on the Office to establish that the references teach or suggest the recited features, relationships, and/or steps. The burden is *not* on Appellants to establish what the references do not teach or suggest (i.e., establish non obviousness). Appellants do not have a legal burden to prove patentability. Conversely, the burden of establishing obviousness resides with the Office, and this burden has clearly not been met by the Office.

The Board has overlooked that the Office must establish obviousness under the law. It is the Office that has the burden of clearly showing that all recited features are taught or suggested

in the references. If the Office does not produce a *prima facie* case of obviousness (which is the current situation), then the Appellants are under no obligation to submit any evidence of nonobviousness (MPEP § 2142). Appellants have a right to view the (alleged) evidence on which their grant of patent is being denied.

The Board has misapprehended its authority in requiring Appellants to prove non obviousness ahead of the Office's burden of establishing a *prima facie* case of obviousness. The law is clear that determinations of patentability must be based on concrete evidence of record set forth by the Office. *In re Lee*, supra. The Board has overlooked the Office's failure to present such concrete evidence. Appellants respectfully submit that because the burden of proof was misapprehended by the Board, the Decision is in clear error.

V.   The Decision is improperly based on teachings not of record
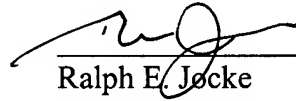
A determination on patentability must be based on evidence of record. As previously discussed, the references do not teach or suggest the features relied upon by the Board. As a result, the Decision must instead be relying on personal knowledge (instead of the prior art teachings of record). To the extent that the Board must be drawing reliance on this personal knowledge to augment the many shortcomings of the applied prior art, Appellants request an affidavit from the Board according to the provisions of 37 CFR 1.104(d)(2).

Conclusion

Appellants have shown herein that there are several points that have been misapprehended or overlooked by the Board in its Decision. As a result, it is respectfully

submitted that the Decision is erroneously based and should be withdrawn, and the rejections

should be reversed.

Respectfully submitted,

Ralph E. Jocke   Reg. No. 31,029
Daniel D. Wasil   Reg. No. 45,303
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256

Customer No. 28995
(330) 721-0000